



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,920	08/24/2001	J. Michael Milliorn	P02167US0	3498
26271	7590	04/26/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			AHMAD, NASSER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

HA

Office Action Summary	Application No.		Applicant(s)	
	09/938,920		MILLIORN ET AL.	
	Examiner		Art Unit	
	Nasser Ahmad		1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 15, 2004 has been entered.

Rejections Withdrawn

2. Claims 22-28 and 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Voy for reasons of record in Office Action mailed on August 28, 2003 in view of applicant's amendment filed on January 15, 2004.

3. Claims 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voy for reasons of record in the Office Action in view of applicant's amendment filed on January 15, 2004.

Response to Arguments

4. Applicant's arguments with respect to claims 22-38 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1772

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 22-28 and 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Voy.

Voy relates to an adhesive label having non-adhesive portions comprising a web consisting of adhesive label substrate having a face material (81), and adhesive layer (85) and a liner (91). The web has a width and a web direction (see figure-2). A plurality of non-adhesive strips positioned between parallel aligned adhesive portions, with the strips and portions being oriented in parallel alignment with the web direction (see figures 9-12, elements 405, 505, 605, 705, respectively). The labels are configured to overlay a non-adhesive strip and an adhesive portion (figures 9-12). The labels are cut into a plurality of labels having pre-selected size and shape (see figures 2, 6 and 9-12). Each label has prints on its front surface (figure-8). Also, figures 1-2 and 6 shows that the plurality of cut labels are in a roll form. The labels can have shapes such as circular, rectangular, oval, etc. (see figures 9-12) and the peripheral non-adhesive portions can be taken as grip tabs protruding from the labels. The square and rectangular labels have a top and a bottom edge. The face stock material can be paper or plastic in that the face layer can be transparent or opaque. The type of adhesive can be selected by the operator. The liner is silicone-coated material (col. 7, lines 57-62). The matrix of waste material is removed (118). Voy also teaches in column 10, lines 19-25 that the periphery of the zone of adhesive of each label is recessed from the outer periphery of

Art Unit: 1772

the labels. This facilitates dispensing of the labels from the carrier sheet in that it leaves an edge free from adhesive attachment to a carrier sheet which facilitates removal of each label and precise positioning in registry with the product. The above underlined phrase clearly directs to "adhesive portion extending to at least a portion of the edge of the cut label".

The intended use phrases have not been give patentable weight because said phrases are not deemed to be of positive limitations.

Further, the process of making the product has not been given patentable weight because the process is not germane to the issue of patentability of the product itself.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voy.

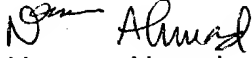
Voy, as discussed above, fails to each that the row includes eight, four or three labels placed horizontally across the width. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide more than one or a plurality of label in a row based on mere duplication of parts. *St. Regis Paper co. v. Bemis Co.*, 193 USPQ 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
April 10, 2004.